

REMARKS

Upon entry of the present amendment, claims 1-8 and 16-18 are pending in this application. Claims 1, 5 and 16 are amended to more clearly define the invention and to correct clerical errors. Claims 9-15 are cancelled, without prejudice or disclaimer. Applicants reserve the right to pursue all cancelled subject matter in a continuing application or applications. No new matter is added.

Formal Matters

Applicants note with appreciation that the Examiner has indicated that the elected species is free of the prior art and that the Examiner has expanded the search to non-elected species.

The Examiner has indicated that claims 15-18 are withdrawn from consideration. Applicants respectfully request clarification. Applicants note that claim 15 relates to a method of decreasing intraocular pressure or improving ocular accommodation by administering a compound of formula I: $Y-Ar^{\oplus} \bullet X^{-}$, where Ar is a 5-membered, nitrogen containing heterocycle. This claim has been cancelled herein.

However, claims 16-18 relate to methods of decreasing intraocular pressure or improving ocular accommodation by administering a compound of formula I: $Y-Ar^{\oplus} \bullet X^{-}$, where Ar is a 6-membered, nitrogen containing heterocycle. Applicants submit that these claims properly depend from amended claim 1 and, thus, should fall within the subject matter of the Examiner's expanded search.

Priority

The Examiner has indicated that the species that was searched does not have support in the provisional application 60/259,429, filed Dec. 29, 2000. Thus, according to the Examiner, the effective filing date of the instant claims is June 6, 2001.

The Examiner indicated in the Office Action that because no prior art was found for the elected species, the search was expended to encompass the non-elected species. The claims, as amended herein, relate to a sub-genus of the originally filed genus of compounds used in the methods of the invention. Applicants submit that this sub-genus of compounds is supported in provisional application 60/259,429, filed Dec. 29, 2000.

Therefore, Applicants respectfully request reconsideration of the priority date of the application in light of the claim amendments made herein.

Claim Objections

The Examiner has objected to claims 1 and 9 for reciting the punctuation "{...}" and "(...)". Claim 9 has been cancelled, and claim 1 has been amended to delete "{...}" and "(...)" and to recite the appropriate punctuation numeral "," as suggested by the Examiner. Thus, these objections can be withdrawn.

Rejection under 35 U.S.C. §103

Claims 1-14 are rejected under 35 U.S.C. §103, as being unpatentable over U.S. Patent 6,596,745 to Gall ("Gall"). The Examiner states that Gall discloses compounds of Formula I and their use in treating disorders of the eye (*i.e.* diabetic retinopathy, cataracts, damage to lens proteins) but does not disclose methods of decreasing intraocular pressure or improving ocular accommodation. However, the Examiner asserts since Gall discloses administration of identical compounds to a person suffering from various eye disorders, one of ordinary skill in the art would reasonably expect the compounds of Formula I to improve ocular accommodation or decrease intraocular pressure. *See*, Office Action pages 3-4. The rejection is traversed to the extent it is applied to the pending claims as amended.

Claim 1, from which remaining claims subject to the rejection properly depend, has been amended to recite a "[a] method of decreasing intraocular pressure or improving ocular accommodation in an animal, including a human, comprising administering an intraocular pressure decreasing or accommodation improving amount of (A) a compound of formula (I): $Y-Ar^{\oplus} \bullet X^{-}$ wherein: a. Ar is a six membered heteroaryl ring..."

It is well recognized under U.S. law, that any rejection of a claim for obviousness over a prior art reference must establish that the prior art reveals that in so making or carrying out [the claimed invention], those of ordinary skill would have a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Gall discloses five membered heteroaryl ring compounds (*i.e.* oxazoles, thiazoles, imidazoles, oxadiazoles, thiadiazoles, triazoles, benzoxazoles and benzothiazoles) and their use for treating diabetic retinopathy, cataracts, damage to lens proteins, whereas the instant invention is drawn to six membered heteroaryl ring compounds and their use for decreasing intraocular pressure or improving ocular accommodation. One of ordinary skill in the chemical arts would readily recognize that there are significant differences between 5- and 6- membered, nitrogen-containing heterocycles. As such, applicants submit that the skilled artisan reading the teachings of Gall would have no reasonable expectation of success in achieving the claimed invention.

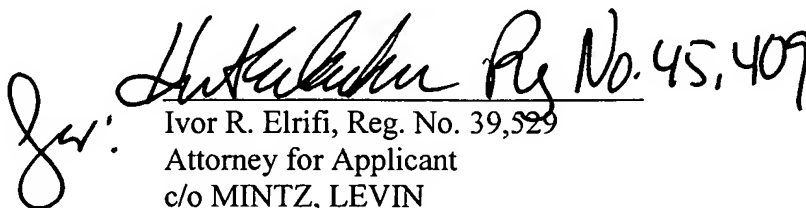
Further, Applicants submit that the compounds used in the Gall methods are sufficiently distinct from the claimed compounds so as to render the instant claims non-obvious. The M.P.E.P. states that a *prima facie* case of obviousness is made when compounds have very close structural similarities and similar utilities. See M.P.E.P. § 2144.09. Examples of very close structural similarities include adjacent homologues and structural isomers, see In re Wilder, 563 F.2d 457 (CCPA 1977), stereoisomers, see In re May, 574 F.2d 1082 (CCPA 1978), and acid and ethyl esters. As amended herein, the claims relate to a method of decreasing intraocular pressure or improving ocular accommodation by administering a compound of formula I: $Y-Ar^{\oplus} \bullet X^{-}$, where Ar is a 6-membered, nitrogen containing heterocycle, while the Gall claims relate to treating diabetic retinopathy, cataracts, damage to lens proteins by administering a compound having a five membered heteroaryl ring. Thus, Applicants submit that the compounds in the amended claims are not structurally homologous to the compounds in Gall.

Since the compounds disclosed in Gall and those claimed in the instant invention are structurally distinct (e.g., not identical compounds, as asserted by the Examiner), Applicants submit that the skilled artisan would have no reasonable expectation of success using the five membered heteroaryl ring compounds of Gall to reach the present invention and respectfully request that these rejections be withdrawn.

CONCLUSION

On the basis of the foregoing amendment and remarks, Applicants respectfully submit that the pending claims are in condition for allowance and a Notice of Allowance for the pending claims is respectfully requested. If there are any questions regarding this application that can be handled in a phone conference with Applicants' Attorneys, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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